

## **REMARKS/ARGUMENTS**

### **I. STATUS OF THE CLAIMS**

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 21-23 and 27 are pending in the present Application. Claims 1-20, 24-26 have been cancelled without prejudice or disclaimer of the subject matter therein. Claims 21-23, and 27 were previously amended in the amendment dated April 26, 2006 and are resubmitted now with the status identifier as previously presented as no further changes have been added with respect to the prior version submitted on April 26, 2006.

Applicant notes that although the Examiner had originally acknowledged withdrawal of claims 1, 5-20 in the May 26, 2005 Office Action, Applicant presently requests that claims 1, 5-20 be cancelled.

This Amendment is submitted in response to the Notice dated July 27, 2006.

### **A. REGARDING ISSUE OF "SHIFTING INVENTIONS"**

Applicant respectfully disagrees with Examiner's assertion that the Applicant is "shifting inventions" during prosecution of the application by now claiming a combination. Applicant submits that the combination of four double locking mortise joints and a tabletop as claimed in Claims 21-23 and 27 require the elements of the double locking mortise joint (the subcombination) as originally claimed. As such, the combination is not a distinct invention from that originally claimed.

According to MPEP § 806.05(c), "[t]he inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability, and (B) the subcombination can be shown to have utility either by itself or in another materially combination". The MPEP further explains:

"Where a combination as claimed sets forth the details of the subcombination as separately claimed, there is no evidence that [the combination] is patentable without the details of [the subcombination]. The inventions are not distinct and a

requirement for restriction must not be made or maintained, even if the subcombination has separate utility...” MPEP § 806.05(c)[I].

As such, the combination claims presented as claims 21-23 and 27 are not distinct from the subcombination mortise joint and Applicant has not switched inventions as asserted by Examiner. Applicant respectfully submits that this response has addressed the issue presented by Examiner and respectfully submits that these claims are allowable.

B. REJECTION(S) CITED BY EXAMINER UNDER 35 U.S.C. §§ 112, 102(b), 103(a)

In the outstanding Office Action, claims 21-27 were rejected under 35 U.S.C § 112, second paragraph, (hereinafter “Section 112”), as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; claims 21 and 24-26 were rejected under 35 U.S.C. § 102(b), (hereinafter “Section 102(b)”) as being anticipated by Elmer, 4,188,067; and claims 22, 23, and 27 were rejected under 35 U.S.C. § 103(a), (hereinafter “Section 103(a)”) as being unpatentable over Elmer, in view of Grisley, 5,711,356.

In response to the rejection of claims 21-27 under Section 112, second paragraph, Applicant has amended claims 21 and 27 to eliminate the language found objectionable by the examiner. Accordingly, the rejection under Section 112, second paragraph, is believed to have been overcome. If, however the examiner disagrees, the examiner is invited to telephone the undersigned who will welcome working with the examiner in a joint effort to derive mutually satisfactory claim language.

Attention is now directed to the rejection of claim 21 as being anticipated by Elmer, and claims 22, 23, and 27 as being unpatentable over Elmer, in view of Grisley. Applicant respectfully submits that claims 21 and 27, as amended, are neither anticipated by nor obvious over the applied references.

Recapitulating briefly, amended claims 21 and 27 define “a plurality of four double locking mortise joints for a table having four table legs, each of said legs being independently and separately removable from every other of said legs, and a tabletop having four tabletop

edges, each of said joints comprising one first mortise on each of said legs” and “one second mortise on each of said tabletop edges of said tabletop.”

The applied Elmer reference clearly illustrates “a chair of knock-down construction, comprising: two legs” [underlining added for emphasis] (Elmer 4,188,067 claim 1, lines 52-53). Applicant considers that the joint illustrated but not claimed in the Elmer reference is intended and only suitable for a chair comprising two legs, a back, and a seat in locked engagement with legs and back. (See Elmer claim 1). It is Applicant’s view that it can be readily appreciated from a perusal of Figures 1, 4, and 5 that the Elmer reference is only configured for use with a chair and has no applicability for use with a table.

In contrast Applicant’s invention is “a plurality of four double locking mortise joints for a table having four table legs, each of said legs being independently and separately removable from every other of said legs, and a tabletop having four tabletop edges.” In addition, amended claims 21 and 27 require that the “tabletop is supported and stabilized by each of said joints without any further supporting structural members or connections existing below a horizontal plane which lies at a joining of said one first mortise and said one second mortise”. Whereas Elmer teaches a “cross-support, extending between the legs, in locked engagement with each of the legs.” (Elmer Col.1, lines 56-59; *See* also Fig. 4). Applicant’s claimed four mortise joints used in combination with each other provide supreme durability and stability not found in the applied references.

Thus, in view of the very nature of Applicant’s invention relative to that taught by Elmer, it is respectfully submitted that Elmer clearly does not serve to teach a person skilled in the art how to provide “a plurality of four double locking mortise joints for a table having four table legs, each of said legs being independently and separately removable from every other of said legs, and a tabletop having four tabletop edges, each of said joints comprising one first mortise on each of said legs” and “one second mortise on each of said tabletop edges of said tabletop.”

Applicant’s invention as recited in amended claims 21 and 27 is believed to be patentably distinct over Elmer, and the deficiencies of Elmer are not believed to be remedied by the secondary references applied in the outstanding grounds for rejection of the dependent claims. Therefore, the references of Elmer and Grisley when considered alone or in proper

combination, are not believed to anticipate or make obvious the combination of features defined by amended claims 21 and 27. Amended claims 21 and 27 are therefore believed to be patently distinct over the applied references. Since amended claims 22 and 23 depend directly from amended claim 21, it is also submitted that amended claims 22-23 are patently distinct over the applied references.

## II. CONCLUSION

In view of the foregoing discussion, no further issues are believed to be outstanding in the present application. The above-discussed amendments and remarks are believed to place the present Application in condition for allowance. Should the examiner have any questions regarding the above amendments, the examiner is requested to telephone Applicant's representative at the number listed below.

Respectfully submitted,

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/Juneko Jackson/

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